

## **REMARKS/ARGUMENTS**

1. The Applicant has carefully considered the advisory action forming part of the official communication dated September 2, 2005. Applicant respectfully submits that the amendment and the following remarks are fully responsive to the advisory action.

2. The claims have been amended in light of the advisory action. It is submitted that no new matter has been added as a result of the amendment.

3. In the advisory action, the Examiner has stated that: “”Intelligent Paper” discloses an intelligent paper made of data printed both in visible ink and invisible ink. It is inherent the intelligent paper is printed by some printer connectable to a network by a publisher...”

4. Applicant respectfully submits that this is not necessarily the case. For example, a printer can be stand-alone. In some of the embodiments described in “Intelligent Paper” the intelligent paper would form part of text books or other mass-published media. It is respectfully submitted that printers generating such material would not be inherently “networked” to a publisher.

5. The Examiner proceeds further to state: “The data printed in visible ink (1<sup>st</sup> information) is inherently stored in some network connectable database.” Again, this is not necessarily the case. For example, the printer for printing the intelligent paper could be connected directly to a stand-alone computational device. Such an arrangement would not be regarded as a network by those of ordinary skill in the art. Clearly, from a reading of the specification, the printer is required to receive and print information from at least two remote sources, such an arrangement constituting a “network” as that word is understood.

6. The Examiner has stated that: “Once the intelligent paper is produced, it is obvious for a producer of that paper to want to test its operability by using the pointer to request second information and see whether this latter can be obtained.” Applicant respectfully submits that this statement makes incorrect assumptions. For example, the invisible ink could be scanned to generate some other action, such as turning on a device at a remote location, as envisaged in “Intelligent Paper”.

7. The Examiner has stated that: "Since the publisher of the intelligent paper has a printer that printed the intelligent paper at his/her disposition, it would have been obvious he/she would use the same printer, for convenience, and designate it as the peripheral to print the test specimen...". Applicant respectfully submits that the Examiner appears to have misinterpreted the relevant claims. On a reading of the claims, whether before or after the current amendment, there are three remote components involved. The first is the printer operable by a user and connected to the network. The second is the first data storage device connected to the network and the third is the second data storage device connected to the network. The publisher (or the provider of the second information) is necessarily remote from the printer so that the user can request the second information from the remote second data storage device. It follows that it is difficult to see how the "publisher" would use the same printer, for convenience.

8. In view of the above paragraphs, the Applicant respectfully submits that the Examiner has not presented a logical line of reasoning. The Examiner has stated that no impermissible hindsight was used. However, Applicant respectfully submits that due to the reasoning presented by the Examiner as set out above, it is clear that hindsight has indeed been used to underpin the Examiner's argument.

9. In spite of the Applicant's submission that the Examiner is incorrect in holding that the present invention does not incorporate an inventive step in the light of "Intelligent Paper", Applicant has nevertheless made some amendments to the claims for the purposes of clarity. The purpose of such amendments is not intended to narrow the scope of the claims as they stood prior to amendment.

10. The Examiner has respectfully been reminded of the provisions of *Hodosh v Block Drug Co. Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed Cir. 1986) in which it was held that when applying 35 USC 103, the following tenets of patent law must be adhered to:

- (a) The claimed invention must be considered as a whole;
- (b) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

- (c) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (d) Reasonable expectation of success is the standard with which obviousness is determined.

11. Applicant respectfully re-iterates that the Examiner has not made out an argument that "Intelligent Paper" suggests the desirability and thus the obviousness of arriving at the present invention. Furthermore, it is respectfully submitted that, as set out above, the Examiner's present conclusion could only have been arrived at with hindsight, which is impermissible.

### CONCLUSION

It is respectfully submitted that all of the Examiner's objections have been successfully traversed. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application are courteously solicited.

Very respectfully,


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